REMARKS

Prior to entry of the Amendment, Claims 12-24, 28, 33 and 49 were pending and under consideration. With this Amendment, Claims 12 and 33 have been amended. Claims 52-64 have been added by amendment. Claims 12-24, 28, 33, 49 and 52-64 are pending and under consideration.

The Amendments of the Claims

Claim 12 has been amended to include additional elements which clarify the nature of the robotic system. Support for this amendment derives from Claims 12 and 33 as originally filed.

Claim 33 has been amended to clarify the nature of the robotic system. Support for this amendment derives from Claim 33 as originally filed.

Claims 52-64 have been added and derive support from original Claim 33 and page 4, lines 5-10.

Accordingly, these amendments do not present new matter and entry is proper.

Rejection of Claims 12-20, 28, 33 and 49 under 35 U.S.C. §103(a)

Claims 12-20, 28, 33 and 49 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentably obvious over Pati (U.S. Patent No. 6,524,856) and Cathcart (WO 91/16675). The rejection is traversed as applied to amended Claim 12 and the remaining claims depending therefrom on the ground that the Patent Office has failed to establish a *prima facie* case of obviousness.

In rejecting claims under §103(a), the Patent Office bears the burden of establishing a *prima facie* case of obviousness (MPEP § 2142). To establish a *prima facie* case, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine their teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest each and every limitation of the rejected claims. The teaching or suggestion to make the claimed combination *and* the reasonable

expectation of success must *both* be found in the prior art, and *not* in Applicants' disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §2142.

Neither the Pati reference nor the Cathcart reference, alone or in combination, teach or suggest a method that uses a robotic system that comprises a computer workstation comprising a microprocessor programmed to manipulate a device selected from the group consisting of a gel loading system, a gene sequencer, an automated transformation system, a colony picker, a bead picker, a cell sorter, an incubator, a light microscope, a fluorescence microscope, a spectrofluorimeter, a spectrophotometer, a luminometer, a CCD camera and combinations thereof.

This deficiency is fatal to the rejection. The Pati reference alone or combined with the Cathcart reference fails to teach each and every limitation of the rejected amended claim.

According to the Patent Office "automating manual activity is not sufficient to distinguish over the prior art," citing *In re Venner* 262 F.2d 91, 95, 120 USPQ 192 (CCPA 1958). In *Venner*, the appellants argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court stated that "it is well settled that it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result."

In *Venner*, however, all elements in the claims, including the automatic means, were disclosed in the applied references (see *Venner* 120 USPQ at 195). In the present case, the Patent Office has not provided a reference which discloses all of the elements present in the claims as amended. In particular, the Patent Office has not provided a reference which discloses a robotic system, as recited in Claim 12, that comprises a computer workstation comprising a microprocessor programmed to manipulate a device selected from the group consisting of a gel loading system, a gene sequencer, an automated transformation system, a colony picker, a bead

picker, a cell sorter, an incubator, a light microscope, a fluorescence microscope, a spectrofluorimeter, a spectrophotometer, a luminometer, a CCD camera and combinations thereof.

In addition, in citing *Venner*, the Patent Office has merely relied upon a *per se* rule that providing a mechanical or automatic means to replace manual activity which has accomplished the same result is unpatentable. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) and as stated by the Board of Patent Appeals and Interferences (see *Ex Parte Richard Brouillet, Jr.* Appeal No. 1998-2297, citing *Venner* and *Ochiai*), "reliance on *per se* rules of obviousness is legally incorrect and must cease."

Accordingly, *prima facie* obviousness is not established and the rejection of Claims 12-20, 28, 33 and 49 under 35 U.S.C. § 103(a) should be withdrawn.

Rejection of Claims 21-24 under 35 U.S.C. §103(a)

Claims 21-24 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentably obvious over Pati and Cathcart, and further in view of Ghai (U.S. Patent No. 5,955,269).

Claims 21-24 depend ultimately from Claim 12. As mentioned above, one of the three requirements of a proper determination of *prima facie* obviousness is that the combination of references relied upon by the Patent Office teach each and every limitation of the rejected claims. Since the combination of Pati, Cathcart, and Ghai fails to do so, *prima facie* obviousness has not been established. Accordingly, the rejection of Claims 21-24 under 35 U.S.C. § 103(a) should be withdrawn.

Conclusion

Applicants submit that amended Claims 12-20, 28, 33, 49 and 52-64 satisfy all of the statutory requirements for patentability and is in condition for allowance. An early notification of the same is kindly solicited.

No fees beyond the fee under 37 C.F.R. §1.17(a)(3) being submitted concurrently herewith are believed due in connection with this Amendment. However, the Commissioner is authorized to charge any additional required fees, or credit any overpayment, to Dorsey & Whitney LLP Deposit Account No. 50-2319 (Our Order No. A-67933-1/AMP/JFB).

Respectfully submitted,

Date: 3/10/04

By: Ann M. Caviahi Pease
Reg. No. 42,067

Dorsey & Whitney LLP
Four Embarcadero Center, Suite 3400
San Francisco, California 94111-4187
Telephone: (650) 494-8700
Facsimile: (650) 494-8771